

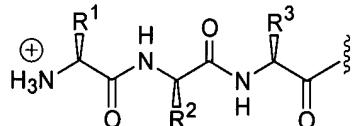
removed to provide greater clarity, since no reference to such a group is made in the peptide nomenclature of these claims. The proposed amendments do not constitute new matter.

## REMARKS REGARDING RECONSIDERATION

Applicants elect as the species, the peptide corresponding to Claim 8(a), for search purposes. Applicants are unable to elect a group for prosecution purposes as the groupings do not appear to encompass the elected species. That is, the peptide corresponding to claim 8(a) is not encompassed by the sequence IDs 1-6 which are listed as the potential groupings by the examiner.

Applicants also object to the Restriction Requirement as the examiner has provided no basis for distinguishing the groups – instead citing only the standard necessary for distinguishing the groups A and B. There is no evidence of record sufficient to establish that the inventions have different modes of operation, different functions, or different effects. Consequently, the burden for distinguishing the sub-groups of A and B has not been met. As a result, Applicants request that new groupings be outlined.

To the extent the examiner believes that the burden has been met, Applicants note that



peptides are chemical structures (as noted by examiner) and a genus claim can be drawn as follows:

It appears that the Applicants are being forced to elect a species, not a group for restriction purposes. The peptide corresponding to elected Claim 8(a) is structurally similar or related to those of claims 8(b) – (c) and 8(e) – (k) since all of these peptides possess the same amide backbone with minimal changes in one to three of the R-group substituents.

Claim 1 is a genus claim which covers multiple species claims. In fact, the genus claim (Claim 1) serves to link the species claims (Claims 8(a) – (c) and (e) – (k)). Based on the Federal Circuit's interpretation of MPEP § 809.3, it is apparent that if the genus claim is allowed, it should preclude restriction between inventions which can otherwise be shown to be divisible. In re Doyle,

2002 WL 1300772 (Fed. Cir. 2002). Thus, according to MPEP § 809.3, restriction to one  $\alpha$ -MSH analog of Claim 8 is likely inappropriate in light of the fact that they are linked by Claim 1 and as a result these species should be examined together.

A comparison of the peptide corresponding to claim 8(a) with those peptides corresponding to claim 8(b) reveals only minimal changes with regard to the R-groups of amino acids 4, 5, 7, and 10. For example the claim 8(b) peptide includes two amino acid homologues with amino R-groups in place of amino acid 10. The differences present in the claim 8(c) peptide are even less substantial, with the only distinction being that amino acid 7 is in the D-form instead of the L-form.

The peptides of claims 8(e) and (f) vary from that of claim 8(a) with regard to the R-group of amino acid 4. In addition the peptide corresponding to claim 8(f) possesses D-Phe instead of L-Phe.

The peptides of claims 8(g) – (j) are fragments of the claim 8(a) peptide, with minimal variations in the R-group substituents. Finally the peptide corresponding to claim 8(k) possesses only minimal variation as compared to the peptide of claim 8(a). In this case there is an R-group variation in amino acid 4 and a variety of amino acids and amino acid homologues which can be substituted for the 5, 10, and 11 amino acids for the claim 8(k) peptide.

In view of the preceding, Applicants respectfully submit that the Examiner appears to be forcing Applicants to elect a species not a group for restriction purposes. Furthermore, in view of the preceding these inventions are not distinct and the search required for the peptide claimed in 8(a) will be the same search required for the peptides found in claims 8(b) – (c) and (e) – (k). Therefore Applicants respectfully request withdrawal of the restriction requirement with regard to the peptides of claim 8(a) – (c) and (e) – (k).

Respectfully submitted,

S Mrksich  
Shannon Mrksich, Ph.D.  
Registration No. 36,675  
Attorney for Applicant

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200